

REMARKS

The Examiner has indicated that neither the Amendment of 6 December 2004 nor the Amendment of 20 August 2004 were in proper format. With respect to the amendments to the specification, the Examiner has requested applicant to “submit these changes to the specification again”. Thus, applicant hereby submits amendments to the specification which include the previously submitted amendments as current amendments as well as additional amendments. These amendments are made to correct typographical errors. With respect to amendments to the claims, and although the Examiner appears to have considered the amendments made in the 20 August 2004 Amendment, the Examiner has requested that applicant “submit a new list of claims have [having] the proper current status for each claim.” Thus, the current listing of claims presented herein lists claim status as the claims were amended by the 20 August 2004 Amendment, i.e., as though the amendments made by the 20 August 2004 Amendment have not yet been made and entered. This appears to the undersigned to be what the Examiner is asking for. If the Claims are to be listed based on the amendments having been already entered, the status of all claims would be “Previously Submitted.”

The Examiner has rejected Claims 1-5, 8 and 9 under 35 USC 112 as being indefinite for use of the phrase “most probable” in referring to “most probable hitting surface”, “club face most probable to impact a golf ball”, and “most probably contact segments of the hitting surface”. Applicant disagrees that the “most probable” language is indefinite. The language used in the application and claims must be taken in the context of the specification and claims and in relation to the prior art and what a person skilled in the art would know. It is submitted that, based on the specification, “most probable” would have meaning to a person skilled in the art.

The goal of every golfer is to be able to hit a golf ball straight in the direction that the golfer wants and intends to hit the ball and to hit the ball an expected distance. A shot that results in the

ball going in the desired direction and for the expected distance is a well hit shot. Every golfer knows, and the prior art teaches, that a well hit shot is a shot where the golf ball is hit substantially in the center of the club. Thus, all golfer try to hit the ball in the center of the club. However, most golfer are not going to be able to hit the ball in the center of the club each time they hit the ball. In trying to hit the ball in the center of the club and to achieve a well hit shot, golfers are going to hit the ball at various place on the club generally hitting most of the balls within a radius of the desired center of the club. The radius from the center within which most golfers will hit most shots is the “most probable hitting surface”, “club face most probable to impact a golf ball”, and “most probably contact segments of the hitting surface”. This will usually be about half way from the center to either the toe or the heel of the club. This area may be defined in different ways, such as the area where a certain percentage of balls will usually be hit, such as the area within which approximately 85% of the balls averaged over a number of hits by a number of golfers will be hit or where a number of repetitive shots from a swing machine will hit the ball, or where a certain portion of a Gaussian distribution of hit balls averaged over a number of hits by a number of golfers will be hit or where a number of repetitive shots from a swing machine will hit the ball. This is not a “most probable” hitting surface or hitting area for a particular golfer with each golfer having their own “most probably” hitting surface or hitting area, but a more generally defined “most probable” hitting surface or hitting area derived from averaging a number of hit by a number of golfers or a number of repetitive shots from a swing machine.

This meaning is consistent with the invention as set forth in the specification and claims. The invention clearly pertains generally to iron-type golf clubs. The prior art section of the application consistently refers to “properly hit” and “off center” hit when referring to hitting a golf ball with a golf club. Thus, iron-type clubs are described as being “increasingly weighted, and the shafts are decreasing shortened to maintain consistent swing momentum so that each club swing, **if properly hit**, decreases the distance the golf ball travels by approximately 10 yards.” The “properly hit” golf ball is hit in the center of the club. Reference is made to “cavity backed clubs” that “do not provide a solid mass behind the club face center to maximize hitting distances.” Various examples of prior art clubs are then given that provide weight behind the “center of the club.” A club is then described that includes a “center weight within the back of the cavity behind the club face to provide added distance to **properly hit** shots”. The specification also acknowledges that most golfers, while trying

to properly hit the ball with the center of the club face, sometimes hit the ball “off center.” The “off center” hit golf ball is hit by the surface of the club “off center” and toward the toe, the heel, or the top of the club face. Thus, the prior art section talks about “heel or toe off center hit shots” and “off-center heel or toe impacts” and describes clubs that tend to lessen the ill effects of such off center shots. These prior art clubs all try to provide straight shots of desired distance over the “most probable” hitting surface or hitting area. However, there are always tradeoffs so that, as explained in the discussion of the prior art, the clubs that extend the hitting area farthest from the center by putting most weight at the sides of the club head give up distance in center shots, and the clubs that put most weight at the center of the club to provide the most distance to well hit shots, give up direction control at much smaller distances from the center. It is then said “There thus remains a need for a rear cavity weighted club which maintains a low center of gravity while providing additional mass behind the center most likely segment of the striking surface of the club to optimize shot distance and move the center of gravity of the club rearward to assist in maintaining alignment even though the shot is off center hit near the toe, heel, or upper segment of the club face.” This statement clearly refers to “most likely segment of the striking surface of the club” as the “center” area of the club, and indicates that a club is needed which provides “additional mass behind the center most likely segment”. The last line of the Summary of the Invention section of the application states: “The invention thus provides an improved tri weight golf club set which not only maintains shot alignment for off center heel and toe iron shots, but provides added distance to well hit center shots.” Again, this clearly indicates that well hit shots, the goal of every golfer, are center shots.

The current invention is described as proving “a tri-weight mass positioned to reinforce the most likely hitting surface of the club and provide perimeter weighting of the toe and heel to straighten out off center hits.” This statement clearly indicated that the most likely hitting surface is not the surface which produces “off center hits.” Thus, the most likely hitting surface must be the center area of the surface. In describing the weight, the first reinforcement sole weight system 30 is described as adding “center weight with most mass placed behind the lower portion of the club face most probable to impact a golf ball during repetitive strokes and least mass proximate the toe and heel. It has increasing mass toward the center of the club . . .”. A third center weight system is described as “attached to the back surface behind the hitting surface above the sole weight inside the cavity with structure to reinforce the upper segment of the most probable contact segments of the

hitting surface above the sole weight and add distance to off-center high hits.” Figs. 1 and 2 clearly show this third weight as in the center portion of the club head behind the center portion or area of the club hitting surface 20. A preferred embodiment of the club of the invention is also described as having the “height of the center weights extend to greater heights depending on the iron number.” Clearly, the whole thrust of the disclosure is that the clubs of the invention should be used as a conventional iron-type club and should be hit in the center area of the club face. A user of the club of the invention, like a user of any other normal golf club, will try to hit the ball in the center area of the club face. In trying to hit the ball in the center area of the club face, many hits will occur in the center area, but some hits will be “off center” and outside the center area of the face. However, with normal golfers using the club of the invention, like normal hitters using any normal golf club and trying to hit the ball in the center area of the club, the “most probably hitting surface”, the “club face most probable to impact a golf ball”, and the “most probable contact segments of the hitting surface”, are the areas around the center of the club. Given that a golfer using the club will try to have a “well hit center shot”, the goal of all golfers, there will be a distribution of areas around the center of the club where the ball hits and which determines the “most probably hitting surface”, the “club face most probable to impact a golf ball”, and the “most probable contact segments of the hitting surface”.

Thus, the meaning of “most probably hitting surface”, the “club face most probable to impact a golf ball”, and the “most probable contact segments of the hitting surface” would be clear from the specification and drawings to a person skilled in the art, and to most other persons, particularly golfers. The terms “most probably hitting surface”, the “club face most probable to impact a golf ball”, and the “most probable contact segments of the hitting surface” are not indefinite and Claims 1-5, 8 and 9 should be allowable.

The Examiner says that the phrases are indefinite because what is most probable for one golfer may not be probably for another. However, applicant is not defining what is most probably for a particular golfer and is not designing a club for a particular golfer. As explained above, “most probable” is applicable to golfers as a whole and represents the area around the center of the club which, if a large number of golfers trying to get a well hit shot hit a ball with the club, represent the area around the center with which most of the golfers would hit the ball. The Examiner cites the case of *Ex Parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989) as supporting his position that a claim may be rendered indefinite by reference to an object that is variable. However,

that is not the situation here. In *Ex Parte Brummer*, the claims referred to the "height of the rider" and to "the combined rider and bicycle weight". The reference in the claims was to properties of the particular rider of the bicycle. The Board pointed out that the claim might be infringed by a bicycle with one rider but not by exactly the same bicycle with a different rider. Applicant's claims do not refer to the "most probable hitting surface" of the particular golfer using the club, but to a general "most probable hitting surface" which has a clear meaning without reference to a particular golfer as pointed out above. Thus, *Ex Parte Brummer*, is not applicable to the present claims.

Please note the enclosed Power Of Attorney to the undersigned. Also, please charge any additional fees due, or credit any overpayments to Deposit Account No. 13-1175 of the undersigned.

Respectfully,

THORPE NORTH & WESTERN



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May 16, 2005
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